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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,603	12/13/2005	Nathalie Benninger	5777	7159
26/36 7590 10/03/2008 SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910				
EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,603

Applicant(s)

BENNINGER ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-59 is/are pending in the application.
- 4a) Of the above claim(s) 32-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 12/13/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The response filed 08/07/2008 has been entered. Currently claims 22-59 are pending and claim 1-21 are cancelled.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 22-31 in the reply filed on 08/07/2008 is acknowledged. The traversal is on the ground(s) that the groups are not properly restrictable because all of the special technical features of independent claim 22 were not taught. This is not found persuasive because the search report issued by the international searching authority is sufficient to provide a presumption of lack of unity of the inventions, which means that all of the special technical features of claim 22 were known in the art. This therefore means there was no special technical feature that defines a contribution over the prior art, which therefore means the inventions lack unity; furthermore, the rejections set forth below establish that all of the special technical features of applicants claim 22 was known to one having ordinary skill in the art.

As a secondary point, the Examiner looked at the reference WO 2002/090002 and found that it does teach a sheet magnet (permanently magnetized material) that is used in the same method of printing as taught by applicants. Given the references cited below as well as the rejection set forth below, it is clear that all of the special technical features of independent claim 22 are known to one having ordinary skill based upon the

combined teachings of WO 02/090002 and the references set forth below. This provides further evidence that there was no special technical feature that defines a contribution over the prior art, and therefore means the inventions lack unity.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 32-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/07/2008.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. The drawings are objected to because Figures 2-5 are too dark as to be difficult to see the engraved markings and magnetized ink layer. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25, 27, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 25, 27, and 30, they recite the limitation "said body" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Perhaps applicants meant "said body of permanent-magnetic material."

With regard to claims 25 and 27, the scope of the claims are confusing because it is unclear whether the **device** is mounted on a rotatable cylinder on a printing machine or on a support, or rather whether the **body** of permanently-magnetic material

is mounted on a rotatable cylinder on a printing machine or on a support. It is unclear whether the device includes the printing machine or the support.

With regard to claim 29, it recites the limitation "said material" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With further regard to claim 29, applicants state that "said material *preferably* fills up said engravings;" however, this renders the claim indefinite because it is unclear whether the material is at all required. If the material does not fill up the engravings then this claim fails to further limit the parent claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

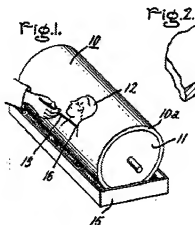
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry (3,011,436) in view of Blume, Jr. (2,999,275).

First, with regard to the requirement in claim 22 that the device is "for magnetically transferring indicia to a wet coating composition applied to a substrate, said coating composition comprising at least one type of magnetic or magnetizable particles" the Examiner deems this to be an intended use limitation, which is not dispositive of patentability. Any article that satisfies the structural limitations will be held

to be able to perform the recited intended use; furthermore, any dependent claim that is drawn to said intended use will also be taught by the reference.

With regard to claim 22 and 26, Berry teaches the device of Figure 1 (col. 2, line 44 to col. 3, line 29).



There is a smooth surfaces ferromagnetic member **10**, which may be comprised of a material of high magnetic retentivity (permanent-magnetic material) such as an Alnico alloy (col. 2, lines 46-49). The image (indicia) **12** may be formed by etching or engraving it into the printing plate as discussed at col. 5, line 48 to col. 6, line 43. This etching will intrinsically perturb the magnetic field of the ferromagnetic outer plate **10**. Clearly the printing plate is cylindrically curved as seen in the Figure; however, Berry does not teach that the magnetic field of the ferromagnetic printing plate is normal to the surface of said printing plate nor does he teach the magnetic materials of claim 26.

Blume Jr. teaches magnetic films that are known to be suitable replacements for Alnico alloys (col. 3, line 74 to col. 4, line 4). The films are made of a polymer material (col. 3, lines 26-32) into which are dispersed ferrite magnetic particles (col. 2, lines 43-69). The nature in which the films are produced lead to the magnetic particles to have

their magnetic field aligned normal to the two longitudinal parallel surfaces (col. 2, lines 63-69 and col. 3, lines 53-57).

Since Berry and Blume Jr. are both drawn to permanent-magnetic materials; it would have been obvious to one having ordinary skill in the art at the time the invention was to substitute the ferrite containing film of Blume Jr. for the ferromagnetic layer **10** of Berry. The motivation for doing is in the fact that Blume Jr. recognizes that his ferrite containing polymer is an excellent substitute for Alnico alloys (col. 1, lines 57-64 and col. 4, lines 1-4); specifically, the materials are cheaper and the manufacturing process as a whole is cheaper, and further, the magnets can be made into a variety of shapes much more easily.

With regard to claim 23, it is clear from the Figure that the etched image into the magnetic layer **10** is a design or image.

With regard to claim 24, this is an intended use of the device. The Examiner deems the device could be used for the desired intended use because it is comprised of all the same materials.

With regard to claims 25 and 27, clearly the magnetic body **10** is mounted on a rotatable cylinder or support.

With regard to claim 30, during the etching process the magnetic particles that are mixed with the etching solution will fill up said engravings/etchings as the etching solution works on the surface of the magnetic material **10**.

10. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry (3,011,436) in view of Blume, Jr. (2,999,275) as applied to claim 22 above, and further in view of Alles (3,458,311).

Berry in view of Blume, Jr. disclose all of the limitations of applicants' claim 22 in section 9 above; however, they fail to disclose that the surface of the device is covered with a non-magnetic material that fills up the engravings in said body of magnetic-material.

Alles discloses a protective layer formed of a plastic material for printing plates (col. 1, line 70 to col. 2, line 20). The organic polymers they are proposing are not magnetic.

Since Berry in view of Blume, Jr. and Alles are drawn to printing plates; it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the surface of the body of magnetic material so as to fill the engravings with the protective layer of Alles. The motivation to do so would be to protect the printing plate and the precisely etched images in said body of magnetic material.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry (3,011,436) in view of Blume, Jr. (2,999,275) as applied to claim 22 above, and further in view of Yamamoto et al. (5,201,268).

Berry in view of Blume, Jr. disclose all of the limitations of applicants' claim 22 in section 9 above; however, they fail to disclose that the surface of said body is surface treating to enable a reduction of friction resistance and/or wear.

Yamamoto et al. disclose a release layer (friction resistance layer) applied to their printing plate (col. 3, lines 5-10).

Since Berry in view of Blume, Jr. and Yamamoto et al. are drawn to printing plates; it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the release layer (friction resistance layer) of Yamamoto et al. on the device of Berry in view of Blume, Jr. The motivation for doing so would be to provide a surface that would not chip or wear and would also allow other substrates to not stick to said body of magnetic material.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner deems that the document WO 02/090002 to be particularly relevant to the issue at hand because it involves the same method of using the device seen in claim 22; however, the Examiner finds the art cumulative to the rejection at hand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins, Ph.D.
Examiner
Art Unit 1794

/Gerard T Higgins, Ph.D./
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794